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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/918,501
Filing Date: August 01, 2001
Appellant(s): HELAINE ET AL.

Andrew J. Taska
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1-15-08 appealing from the Office action mailed 7-16-07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every

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means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because it does not provide a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number. Appellant is introducing arguments in the summary of the claimed subject matter on pages 8-9.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6035193	Buhrmann	3-2000
6029065	Shah	2-2000
EP0748136	Sipila	11-1996
6434399	Kasmperschroer	8-2002
5924014	Vanden Heuvel	7-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-2, 9 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Buhrmann US 6,035,193 in view Shah US 6,029,065.

As to claims 1, 15 and 16, Buhrmann discloses an automatic network services management method comprising: connecting a communication terminal of a first network is connected to a private base (see col. 1, lines 6-9), connecting said private base is connected to a second network (see fig. 1; col. 3, lines 29-39), and a memory establishing service codes of said first network (see col. 7, lines 57 –col. 8, line 10). Buhrmann does not specifically disclose the memory establishing correspondence. In an analogous art, Shah discloses the memory establishing correspondence (see col. 3,

lines 35-40; col. 7, lines 4-17). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention to combine the Shah and Buhrmann teachings for the simple purpose of compatibility between networks (see Shah col. 1, lines 5-10).

As to claim 2, Shah discloses the method of using a correspondence memory in the communication terminal (see col. 4, lines 1-9)

As to claim 9, Shah discloses the method wherein said correspondence memory is updated between a call of between the terminal and the first network (see col. 10, lines 31-35).

As to claims 12 and 13, Shah discloses the method wherein said first network is a mobile telephone network and second network is a terrestrial telephone network (see col. 1, lines 14-17).

As to claim 14, Shah discloses the method wherein said mobile communication terminal is automatically connected to said private base when said terminal is within range of said base (see col. 6, lines 40-44).

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and further in view of Sipilä (EP 0748136A1).

As to claim 3, Shah discloses everything claimed as explained above (see claim 1) except for the method wherein said correspondence memory is in said private base. In an analogous art, Sipilä discloses the method wherein said correspondence memory is in said private base (see col. 2, lines 3-11; col. 9, lines 27-52), therefore allowing the updated features be used in legacy terminal. Therefore, it would have been obvious to

one of the ordinary skill in the art at the time of the invention to add this technique for the simple purpose of compatibility with old terminals.

5. Claims 4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and Sipilä as applied to claim 3 above, and further in view of Kasmperschroer (U.S. Patent US006434399B1).

As to claim 4, Shah the method wherein: a request corresponding to a service is composed from said communication terminal (see col. 9, lines 1-3), said request is sent from said communication terminal and received at said private base (see col. 9, lines 13-15). Shah does not specifically disclose said request is sent to said second network and is received by an operator managing said services of said second network, or wherein said request is updated in said private base as a function of said correspondence memory. Sipilä discloses wherein said request is updated in said private base as a function of said correspondence memory (see col. 9, line 26 - col. 10, line 3). Sipilä does not specifically disclose said request is sent to said second network and is received by an operator managing said services of said second network. Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second network (see col. 7, lines 6-24). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Sipilä method to ensure compatibility in the connection.

As to claims 6 and 7, Kasmperschroer disclose processing of said request by an operator managing said services of said second network (see col. 7, lines 6-24). Shah

discloses the method wherein an acknowledgement is received at said communication terminal or private base (see col. 11, lines 13-22). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple purpose of confirms the delivery of data.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and Sipilä and further in view of Kasmperschroer as applied to claims 4 and 6-7 above, and further in view of Vanden Heuvel (U.S. Patent US005924014A).

As to claim 5, Sipilä discloses the method wherein, if said correspondence data contains no match to said request sent by said communication terminal send an error message (see col. 9, lines 13-17). Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second network (see col. 7, lines 6-24). Sipilä and Kasmperschroer do not specifically disclose transmitting without changing the format. Vanden Heuvel discloses transmitting without changing the format (see col. 10, lines 16-21). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the modified Sipilä and Kasmperschroer method for the simple purpose of compatibility.

7. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and Kasmperschroer.

As to claim 8, Shah discloses everything claimed as explained above (see claim 1) except for the method wherein said correspondence memory is updated during a call between said private base and an operator. In an analogous art, Kasmperschroer the

method wherein said correspondence memory is updated during a call between said private base and an operator (see col. 7, lines 6-24)., thereby allowing to updated the services between the system. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine both teachings for enhanced compatibility between systems.

As to claims 9, Shah discloses the method wherein said correspondence memory is updated automatically (see col. 6, lines 40-45).

As to claim 11, Shah discloses the method wherein said updating is triggered by a user (see col. 10, lines 46-48).

As to claim 10, Shah discloses the method wherein said correspondence memory is updated periodically. However, OFFICIAL NOTICE IS TAKEN THAT the technique of updating memory periodically it is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple reason of refresh the memory cycle and preserve the data.

(10) Response to Argument

Appellant's first argument about the grounds of rejection have failed to establish even a prima facie case of obviousness because they have failed to demonstrate that either Buhrmann, Shah or any combination thereof, teaches or suggests the feature of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and services codes of a second network which is connected to a private base station, it is noted that appellant arguments against

the references individually in the entire appeal, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Buhrmann discloses the method of connecting a dual mode communication terminal [10, 11] of a first cellular network to a private base station [20] (see fig. 1, items 10, 11, 20; col. 1, lines 6-9); connecting said private base [20] to a second landline network [14] (see fig. 1, items 14, 20; col. 3, lines 29-45), also Buhrmann discloses a memory of the services codes (see col. 7, line 57 – col. 8, line 10), but it does not do any conversion [correspondence] between the service codes.

A service code is a numerical code commonly preceded by an asterisk used to activate or deactivate services or functions in a communication system. Buhrmann gives the example of activating callback by using *69.

In an analogous art Shah discloses a correspondence memory which is used by the processor of the mobile device to convert the user entered codes to the downloaded service codes which will establish correspondence between the service codes of the of the home network and the visited network (see col. 3, lines 35-53; col. 7, lines 4-17, 35-55). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to add the correspondence memory of Shah to Buhrmann to avoid the inconvenience of have to learn all the service codes of all networks as disclosed by Shah in col. 1, lines 5-10. But even though the private base station have the same problem of changing the service codes, appellant states that it would not have been

obvious to one of the ordinary skills in the art to apply the same technique to a private base station. The examiner points that it would have been obvious to one of the ordinary skill in the art at the time of the invention to use the above teachings in a private base station since it is the same solution bringing the same predictable result of converting the service codes as any other network.

Appellant argues that public base stations are fundamentally different than the private base station and cite several differences; however every single difference cited by appellant have nothing to do with service codes. For example, appellant had failed to explain how transmission power affects in any way service codes. Appellant states that Shah provides no teachings or suggestion of using micro or Pico cell; first, one of the ordinary skill in the art would realize transmission power levels does not affect in any way the service codes and it would be obvious that the teachings also applied to any base station since the ending result would be the same; second, the primary reference Buhrmann discloses using a private base station which use low power (see col. 3, lines 48-52) and the correspondence memory of Shah is added to Buhrmann system, thereby the combination of the references teach all the limitations. And last, the claims do limit the range or coverage of the private base station.

To clear any doubt to the appellant about the term Picocell the Newton's Telecom Dictionary 20th Edition define Picocell: A wireless base station with extremely low output power designed to cover an extremely small area such as one floor of an office building.

Appellant repeats the argument that the ground of rejection do not identify any aspect of the cited references to correspond to the specific claimed combination including a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and service codes of a second network, which is connected to a private base station; again, appellant arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Buhrmann discloses the method of connecting a dual mode communication terminal [10, 11] of a first cellular network to a private base station [20] (see fig. 1, items 10, 11, 20; col. 1, lines 6-9); connecting said private base [20] to a second landline network [14] (see fig. 1, items 14, 20; col. 3, lines 29-45), also Buhrmann discloses a memory of the services codes (see col. 7, line 57 – col. 8, line 10), but it does not do any conversion [correspondence] between the service codes. In an analogous art Shah discloses a correspondence memory which will establish correspondence between the service codes of the networks (see col. 3, lines 35-53; col. 7, lines 4-17, 35-55). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to add the correspondence memory of Shah to Buhrmann to avoid the inconvenience of the user have to learn all the service codes of all networks as disclosed by Shah in col. 1, lines 5-10. Also, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use the above teachings in a

private base station since it would bring the same predictable result of converting the service codes as any other network.

Regarding appellant arguments that rather identifying the specific portions of the references that teach or suggest the claimed correspondence memory, the ground of rejection simply allege that it would have been obvious to combine the teachings; examiner invites the appellant to review the prior office action were a specific citation is shown for each reference. In a nutshell Shah discloses a mobile station visiting a network, downloading the service codes to the memory of the mobile device and using that data to convert the user entered codes into the codes of the visiting network (see col. 3, lines 35-53; col. 7, lines 4-17, 35-55), thereby having a correspondence memory between the user network codes and visited network codes. And combining this with the Buhrmann reference would bring a dual mobile phone that when is visiting a private base station would use the same memory to convert the entered service codes to the service codes of the visited network to avoid the inconvenience of have to learn all the service codes of all networks as disclosed by Shah in col. 1, lines 5-10. Thereby, the combination of Buhrmann and Shah do arrive to the same recitation of claim1.

Appellant again alleges that The combination of Burhmann and Shah do not achieve the claimed invention because a skilled artisan would have to further modify the proposed combination; as previously shown, one of the ordinary skills in the art with the teachings of Burhmann and Shah would have absolutely no trouble to achieve the claimed invention because it would bring the same predictable result of converting the service codes as any other network. Appellant cited that Buhrman does not have the

correspondence memory and that Shah do not have the private base station, examiner remind the appellant that rejection in record is a combination of both reference and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to appellant argument that Shah provides no indication whatsoever that the teachings could be successfully applied to the fundamentally different configuration of Buhrmann's private base station, much less that such teachings could be implemented between the networks of a wireless radio telephone and the landline network of a private base station; first, none of the independent claims disclose that the second network is a landline network [only claim 13]; second, none of the previously considered fundamentally different configurations affects in any way the functioning of the service codes; third, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use the above teachings in a private base station since it would bring the same predictable result of converting the service codes as any other network. For example, in Buhrmann discloses that the service code for callback is *69 (see col. 7, line 57 – col. 8, line 10), maybe in other network *68 or *70 is used, even the service code numbers to activate services changes, the activation method is still the same, no matter if the base station is public or private is still the same method bringing the same predictable results. Therefore, the references can be successfully applied by one of the ordinary skill in the art at the time of the invention to a private base station.

Regarding appellant argument that the examiner failed to provide any substantive response to the appellant argument in the action mailed 10-17-07; the examiner answered the substance of the argument when responded to the appellant that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references, and appellant is still attacking the reference individually. As previously stated the combination of both references teaches all the limitations and even arguendo the method is not affected if the base station is public or private since all fundamental difference shown by the appellant do not affect the function of the service codes.

Appellant states: "The examiner allegations that appellant has failed to mention how fundamental differences between public and private base station affect features codes do not substantively respond to appellant's argument that both Buhrmann, Shah... fails to teach or suggest a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and services codes of a second terminal connected to a private base", it is noted that is the appellant who brings the arguments about the fundamental differences between public and private base station, however in order for the argument to be persuasive the appellant have to show that the invention would not be obvious, but if the appellant cannot substantiate its own arguments by failing to explain the differences of the base stations with respect to the services codes, the arguments moots themselves. Please, see above for how the combination of Buhrmann and Shah disclose the limitations.

Also appellant states that the current rejections are improper regardless of how the fundamental difference between private base station and public base station, because Shah fails to teach a correspondence memory between the services codes of a first network of a communication terminal and service codes of a second network connected to private base; interestingly in the assumption nothing had changed is still the same argument citing that the base station is private. Thereby, please see the above paragraphs.

As to appellant argument directed to the motivation to combine the references, appellant recite "Shah does not support the alleged motivation for which it is cited. Shah teaches that it is desirable to provide a user-transparent conversion of network feature codes in a mobile station to facilitate the mobile station's access to a visited public mobile telephone network. Therefore, if anything, a skilled artisan would look toward Shah for teachings regarding how to convert feature codes in a mobile station as the mobile station switches to a visited public mobile telephone network. However, Shah does not provide any motivation for a skilled artisan to establish a correspondence between service codes of Buhrmann's public wireless radio telephone's network and service codes of the landline network of Buhrmann's private base station, as suggested by the grounds of rejection", one of the ordinary skills in the art would recognize that the user wants a transparent conversion of network features between networks as admitted by the appellant, since the user is not interested if the visited base station is private or public he wants transparent conversion of network features of the visited network, and since the dual mode mobile station of Buhrmann is designed to use private base

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stations, one of the ordinary skill in the art would also include the use of a private base station in the correspondence memory of Shah to give transparent conversion of network features between networks as admitted by the appellant.

The rest of the arguments they fall for the same reasons as shown above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Marcos L Torres/

Examiner, Art Unit 2617

Conferees:

/William Trost/

Supervisory Patent Examiner, Art Unit 2617

/George Eng/

Supervisory Patent Examiner, Art Unit 2617